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REMARKS**Status of the Claims:**

Claims 1, 3, 4, 5, 14, 15, 21, 23-26 are hereby amended. Claims 1, 3-6, 8-11, 13-16, 18-21, 23-26 are now pending in the application, of which claims 1, 11, and 21 are in independent form.

Claims 1, 3, 4, and 5 were amended to recite that the second location is a confidential location that is selected and arranged to be a location that is not generally known. Claims 11, 14, and 15 were amended to recite that the second location is a confidential location. Claims 21 and 23-26 were amended to recite that the second location is a predetermined secret second location, where information printed at the predetermined secret second location cannot be clearly perceived unless the second information is viewed using a magnifying lens by a party with knowledge of the predetermined secret second location.

All claims as amended are supported throughout the Application, Claims, Figures, and Specification as originally filed. No new matter has been added.

The 103 Rejections

Claims 1, 3-6, 8-11, 13-16, 18-21, 23-26 are now pending in the application and all are rejected in the above-identified Office Action. Claims 1, 11, and 21 are the independent claims in this application.

All rejections now standing in the application are under 35 USC 103(a) as being unpatentable over UK Patent GB-2159461A ("the UK patent") in view of US 1428278 to Dow ("the Dow patent") and further in view of Waly (3,704,068) ("the Waly patent").

The Examiner contends in the rejection that the UK patent teaches all elements of claim 1 except the feature of minimal contrast hiding printed matter from the naked eye wherein the printed matter and a background color are printed in various hues. The rejection then states that the Dow patent teaches minimal contrast as recited in claim 1. The rejection acknowledges that the UK patent as modified by Dow fails to teach that the second printed matter can only be viewed using a magnifications lens, but goes on to say that because the Waly patent discloses a

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reader having a lens adapted to enlarge a micro image, one skilled in the art could modify the combined UK and Dow document so that it could be placed into the reader of Waly.

Applicants respectfully submit that the Examiner's rejection does not establish a prima facie case for obviousness. As Examiner knows, the requirements for a prima facie case of obviousness are set forth in MPEP 706.02(j) and MPEP 2143 and require that:

1. **There must be a suggestion or motivation to modify the references, either in the references themselves or in the ordinary skill in the art.**
2. **There must be a reasonable expectation of success; and**
3. **The combination of references must teach all elements of the claim expressly or inherently.**

Note also MPEP 706.02(j) further states that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As to the third criterion above, Applicants submit the combination of references does not teach or suggest all elements of claim, as amended, whether expressly or inherently. Claim 1, as amended, recites:

An identification document comprising:

first printed matter rendered at a first location on said document and at a first scale enabling said first printed matter to be resolved by a viewing person without magnification, said first printed matter conveying identifying information;

second printed matter comprising information that communicates the same identifying information as said first printed matter, the second printed matter rendered at a second microscale and at a second confidential location on said document and in a second color, said second microscale being significantly smaller than said first scale, said second confidential location being spaced from said first location and being selected and arranged to be a location that is not generally known, and said second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background;

wherein the combination of said minimal contrast, said second confidential location, and said second microscale is constructed and arranged to substantially hide the existence and location of said second printed matter from the naked eye and prevent said second printed matter from being substantially detected or resolved unless the viewing party knows the second confidential location and said second printed matter is viewed using a magnification lens.

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Applicants respectfully disagree that the combination of the UK patent, Dow, and Waly discloses the invention in the claims, as amended. In particular, it appears that none of the cited art of record, taken alone or in combination, teach or suggest printing second printed matter at a second microscale and in a second confidential location, wherein the combination of said minimal contrast, said second confidential location, and said second microscale is constructed and arranged to substantially hide the existence and location of said second printed matter from the naked eye and prevent said second printed matter from being substantially detected or resolved unless the viewing party knows the second confidential location and said second printed matter is viewed using a magnification lens.

Specifically, Applicants note that the structure provided by the combination of the UK patent, Dow, and Waly is not equivalent to the structure of claim 1, because none of the art, taken alone or in combination, teach or suggest that the disclosed structure includes second printed matter printed at a confidential location. Printing the second printed matter at a second microscale and in a second confidential location provides a functional, structural advantage in that the confidential location works with the microscale and minimal contrast to hide both the existence and the location of the second printed matter. As noted in Applicants' Specification at page 1, lines 5-10, not publicizing the location (and/or not publicizing the existence) of the identifying information printed at the microscale provides a further functional advantages in the detection of alterations and counterfeit documents.

The UK patent is thoroughly silent as to teaching or suggesting that the location and existence of the microfilm data it provides on its credit card is (or could be) confidential. All of the Figures (and accompanying description) illustrate that anyone looking at the card with the naked eye would be alerted to at least the location and existence (if not the content) of the microfilm on the document of the UK patent. The *location* and *existence* of the microfilmed information on the UK patent's document is disclosed only as being completely visible to the naked eye, which is completely different to the invention recited in claim 1, as amended. The UK patent is similarly thoroughly silent as to the need to hide the location and/or existence of the microfilm data, such as by keeping the location confidential and/or by forming it onto the document so as to have minimal contrast with its immediate background. **Thus, Applicants**

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respectfully submit that there would be no motivation to modify the UK patent with the Dow patent, so the first obviousness criteria above (i.e., the motivation) is not present.

Applicants further submit that the second criterion (reasonable expectation of success) likewise is not taught by the claimed combination. In one embodiment of the UK patent, the microfilm (which is never taught or suggested to be "invisible" to the naked eye) is placed in a clear window (col. 1, line 40 through col. 2, line 77). This structure cannot meet claim 1's structural requirement that the information printed in microscale be "selected and arranged to be a location that is not generally known". Even if this structure were modified by the Dow reference (and the Waly reference), it would not achieve the present invention as recited in claim 1 (as amended) and would not meet claim 1's requirement that the second printed matter be in a second color the "second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background", because the background is clear.

In the other disclosed embodiment in the UK patent, the microfilm is placed on a "white or other suitable light colour" (col. 1, line 89) backing and covered with a "clear transparent plastic film" (col. 1, lines 104-105). Accordingly, Applicants do not see from where the motivation to modify this reference using the Dow patent would arise. Moreover, Applicants note that this structure (even if modified by the Dow reference) does not meet claim 1's structural requirement of being in a confidential location. The UK patent neither teaches nor suggests that the location where it applies the microfilm/microprint is kept confidential. The Waly reference similarly does not teach use of a confidential location. Because the microfilm is not taught or suggested to be anything other than conventional microfilm or microprint, Applicants believe that its location and existence (if not its content) would be visible to the naked human eye, and thus could not be confidential. Public knowledge of the existence and/or location of the microfilm information appears to be an important aspect of the UK patent, since the UK patent's example of an intended use states that a mere "counter clerk" in a "retail establishment" would be able to check the information in an appropriate reader (col. 2, lines 14-23).

As to claim 1's description of "minimal contrast", Applicants again repeat their observation that the Dow reference does not teach use of printing information so as to have

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minimal contrast with immediate background while simultaneously also being located in a confidential location and being viewable using a magnifying lens (if one knows the confidential location), as recited claim in 1, as amended. Dow teaches the use of inks that look the same to the naked eye but look completely different when viewed using **specific specialized equipment** used to bring out specific optical properties of the ink (see Col. 1, line 44 through col. 2, line 76). The specific equipment mentioned--spectroscopes or equivalent equipment that is sensitive to true or fundamental colors— have nothing to do with magnification, are not the same thing as a magnification lens, and thus are completely different than what is described in the pending claims as amended. If one were to modify the UK patent with the Dow patent, the resultant microfilm or microprint could not necessarily be viewed using a magnifying lens. Rather, one would need the "proper apparatus" (col. 1, lines 18-19), namely the spectroscope or equivalent described above.

Further modifying the combination of the UK patent and Dow patent with the Daly patent would take the combination even further away from the recitation of claim 1, as amended. The reader of Waly is not really a "magnification lens", which lens would be usable with virtually anything that one wants to see in an enlarged state. Rather, the reader of Waly must be used with very specific, specially prepared images. Waly's reader is intended to be used with "specially prepared, interlaced microimages appearing on a multiple-image microrecord" (col. 1, lines 8-10) which documents "are not recorded in discrete frames, but are interlaced on a common surface to produce a multiple image micro-record which may be read back by selectively enlarging only those characters or bits of information on the surface . . ." (col. 3, lines 4-10). Moreover, Waly never teaches or suggests that any of the specially prepared images can be in a confidential location or can be printed so as to have minimal contrast with their immediate background, so Waly does not compensate for the deficiencies of the UK Patent and the Dow patent.

MPEP 2143.01 states that a proposed modification cannot change the principle of operation of a reference. Applicants submit that the modifications as suggested by the Examiner would **change the principle of operation** of the UK patent. For example, the UK patent expressly states that its microprint information "*cannot be ascertained or readily ascertained by the naked eye (even with the aid of a magnifying lens)*" (see col. 2, lines 127-130). The

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microprint of the UK reference has this quality because the card of the UK patent is specifically constructed and arranged to have this information be viewable only using a special viewer—not a magnifying lens (see FIG. 1 of the '461 patent as well as col. 1, lines 45-77 and col. 1, line 127 to col. 2, line 10).

In stark contrast, in the present invention, the second printed matter of claim 1 as amended is specifically described as being able to be resolved using a magnification lens. This provides the advantage (as stated in the Specification at page 1, lines 1-5) of being able to determine the authenticity of an identification document produced in accordance with the invention in a cost efficient manner (through use of low cost equipment such as a magnification lens). Both this feature and its use are entirely different from that described for the microprint (3) of the '461 patent. The microprint (3) of the '461 patent is read by inserting the portion of the card containing the microprint (2) into a special reader or projector then reading the information in greatly enlarged form on a screen (see col. 2, lines 4-23). For this reason Applicants further submit that the microfilm or microprint information of the UK reference is not even equivalent to the "second printed matter rendered at a second microscale" of claim 1, as amended. Thus, Applicants again submit that the proposed combination does not teach all of the elements of the claim, expressly or inherently.

Additionally, as previously noted, the UK patent neither teaches or suggests that its microprint information (3) is there to communicate the same identifying information as information printed elsewhere in the card. In the UK patent, the microprint information (3) is described as providing details on the authorized holder, such as a photograph, medical data, account number, etc. (see col. 1, lines 107-119). This information is not described as being printed in visible (to the naked eye) form anywhere else on the card, which is understandable because much of the microprint information (3) is described as personal information such as bank account information, credit limit, medical records, etc. The other (visible) information on the card is described in the '461 patent as being embossed information such as the holder's serial number, name, validity dates, and/or holography. The UK patent does not teach or suggest that any portion of the visible information on the card (which the Examiner contends corresponds to the "first printed matter" of claim 1) is hidden in a confidential place elsewhere on the card. The UK patent seems to be silent about whether any of the microprint information (3) is

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communicates the same information as information visible to the naked eye that is also visible to the naked eye elsewhere on the card. This is particularly pertinent, because providing information that is printed on the face of the card in "hidden" or "camouflaged" form elsewhere on the card serves as a security feature in claim 1, as amended. The Dow and Waly references do not compensate for these deficiencies in the UK patent.

For at least the above reasons, Applicants maintain that claim 1, and all claims dependent therefrom, namely claims 3-6, and 8-10, are patentably distinguishable over the art of record, whether taken alone or in combination, and are in a condition for allowance. Applicants respectfully request that the rejection of these claims over the UK patent in view of Dow and Waly be withdrawn.

Claims 11 and 21 have been amended in a similar vein as the above-described amendments for claim 1. Claim 11 was amended to recite that the second location is a confidential location, and claim 21 was amended to recite that the second location is a predetermined secret second location, where information printed at the predetermined secret second location cannot be clearly perceived unless the second information is viewed using a magnifying lens by a party with knowledge of the predetermined secret second location. Applicants hereby repeat as to claims 11 and 21 the arguments made previously for the patentability of claim 1.

For at least these reasons, Applicants submit that claims 11 and 21, and all claims dependent therefrom (namely, claims 13-16, 18-20 and 23-26, respectively) are patentably distinguishable over the art of record, whether taken alone or in combination, and are in a condition for allowance. Applicants respectfully request that the rejection of these claims over the UK patent in view of Dow and Waly be withdrawn.

Applicants note that the Office Action stated a belief that the prior art structure was capable of performing the intended use and requested that Applicants further disclose the structure of the identification document. Applicants believe that the claim amendments herein, particularly the recitation that the second printed matter be disposed in a confidential location, further detail the structure of the claimed subject matter.

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Closing Remarks

Applicants believe that all pending claims are patentably distinguishable over the art of record and are in a condition for allowance. Favorable consideration and an early notice of allowance are hereby respectfully requested. Should the Examiner have any questions, he is invited to contact the undersigned at 781-744-6404.

This Amendment and Response does not add any new claims to the This Amendment and Response is being faxed to the Examiner's Technology Center on August 26, ; thus, Applicant hereby petitions for a two month extension of time. Please charge such fee to PTO Deposit Account No. 50-2535. A copy of a petition for extension of time is enclosed.

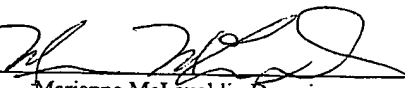
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Respectfully submitted,

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